

### **AMENDMENTS TO THE DRAWINGS**

Please amend the drawings by replacing Fig. 1 with the enclosed replacement sheet. The lead line for reference number 33 is amended to remove the arrow. No other amendments are made to the drawings.

### **REMARKS/ARGUMENTS**

Initially, the applicants would like to thank the examiner for the recognition of allowable subject matter in claim 27. The examiner will note that claim 27 has accordingly been amended in accordance with the suggestions of the examiner and thus is now in condition for allowance.

With respect to the remaining claims, by this amendment, claims 1, 3, 13, 19, and 26 are amended, and the drawings are amended. Support for the amendments to claims 1, 13, and 19 may be found in the specification and claims as originally filed. Specifically, the relative orientation of the first and second surfaces of the flexible substrate and the first and second plies is disclosed in Figs. 7 and 8 as originally filed. Claim 3 is amended in its dependency only. Claim 26 is amended to correct a minor typographical error. Support for the amendments to the drawings may be found in the specification and claims as originally filed. Thus, no new matter is added and claims 1-27 remain pending with claims 1-26 at issue.

### **Amendments to the Drawings**

Fig. 1 is amended to show the opening in the lower portion of the flexible sheet (12) labeled with the numeral 33 and a lead line. This feature was labeled with numeral 33, lead line and an arrow in the previous amendment.

Additionally, the applicants respectfully disagree with the examiner that the foldable stand 13 added in the last amendment constitutes new matter. The examiner states in this action that "the drawings must show every feature of the invention specified in the claims. Therefore, the easel defined in claims 10-12 and 26 must be shown or the feature(s) cancelled from the claim(s)." The applicants respectfully submit that the foldable stand 13 is the easel of claims 10-12 and 26 and direct the examiner to page 11 of the response filed on January 4, 2005, which states in the second paragraph, "FIG. 1 has been amended to comply with 37 C.F.R. § 1.83(a) by showing easel 13, and appropriate lead line, recited in claims 10-12 and 26." Thus, no new matter is added because support for the easel 13 may be found in at least claims 10-12 and 26 as originally filed. The applicants respectfully request withdrawal of the objection to the drawings.

### **Claim Objections**

The applicants respectfully traverse the objection to claims 3 and 19. By this amendment, claims 3 and 19 are amended to correct the informalities objected to by the

examiner. In particular, claim 3 is amended to depend from claim 2, thus providing antecedent basis for “the first and second mounting holes”, and claim 19 is amended to correct a typographical error and now recites “first and second plies”. The applicants submit that claims 3 and 19 are now in proper form and respectfully request withdrawal of the objection.

### 35 U.S.C. § 112 Rejections

The applicants respectfully traverse the rejection of claims 1-12 and 19-27 as indefinite. Specifically, amended claims 1 and 19 no longer recite a “closed” interior. Thus, the applicants respectfully request withdrawal of the rejection of claims 1-12 and 19-27.

### 35 U.S.C. § 102 Rejections

The applicants respectfully traverse the rejection of claims 1, 2, 4, 5, 8-11, 19 and 21-25 as anticipated by U.S. Patent No. 4,085,534 to Eckstein et al. (“Eckstein”), U.S. Patent No. 4,226,039 to Young (“Young”) or U.S. Patent No. 4,085,535 to Schweinsberg (“Schweinsberg”). Each of claims 1, 2, 4, 5, 8-11, 19, and 21-25 recites, *inter alia*, a flexible substrate having a first and second surface, a file pocket adjacent to the first surface, the file pocket including a first ply foldably connected to a second ply, a first tab formed integrally to the first ply and adapted to fixedly engage the file pocket to the second surface and a second tab formed integrally to the second ply and adapted to expandably engage the file pocket to the second surface, wherein the first surface is disposed between the second surface and the first ply. None of the cited art discloses a flexible substrate having first and second surfaces, a file pocket adjacent to the first surface, the file pocket including a first ply foldably connected to a second ply, a first tab formed integrally to the first ply and adapted to fixedly engage the file pocket to the second surface, a second tab formed integrally to the second ply and adapted to expandably engage the file pocket to the second surface, wherein the first surface is disposed between the second surface and the first ply.

While Eckstein discloses a data carrier having a plurality of members each having a tongue and slot, wherein clamping members are used to secure the lateral sides of the members together, Eckstein fails to disclose first and second surfaces of a substrate wherein the first surface is disposed between the second surface and a first ply, as is recited in each of claims 1, 2, 4, 5, 8-11, 19 and 21-25. Specifically, as the examiner asserts in the action, Eckstein includes a piece of material 9 having two surfaces, the first surface being the back surface and the second surface being the front surface. According to this interpretation of the

teachings of Eckstein, there is no possible way that the first surface (i.e., the back surface) of the material 9 could be disposed between the second surface (i.e., the front surface) and the material forming the slip-in compartments 2. (See, for example, Fig. 1)

Additionally, while Young discloses a pocketed holder including a frame piece 2 having first and second sides and a panel 5, 6 that includes front and back walls 18, 19, Young does not disclose the first side being disposed between the second side and the panel 5, 6. In particular, as defined by the examiner in the action, the frame first side is the front surface of the frame and the second side is the recess which receives the first and second plies. Thus, the first side is not and could not be disposed between the second side and the panel 5, 6. (See, for example, Figs. 2 and 3)

Likewise, while Schweinsberg discloses a data carrier having clamping members 2, 3 having a first surface (the front of the clamping member), and a second surface (the surface forming the recess) and a panel member 9, Schweinsberg fails to disclose the first surface being disposed between the second surface and the panel member. By fixedly engaging the panel member to the second surface, the Schweinsberg device does not and cannot arrange the first surface to be disposed between the second surface and the panel member. (See, for example, Figs. 2-4)

Because Eckstein, Young and Schweinsberg fail to disclose a first surface disposed between a second surface and a first ply, none of claims 1, 2, 4, 5, 8-11, 19 and 21-25 can be anticipated by Eckstein, Young or Schweinsberg. Thus, the applicants respectfully request withdrawal of the rejection of claims 1, 2, 4, 5, 8-11, 19 and 21-25.

### **35 U.S.C. § 103 Rejections**

The applicants respectfully traverse the rejection of claims 3, 6, 7, 12-18, 20 and 26 as obvious over any combination of Eckstein, Young, Schweinsberg, U.S. Patent No. 6,349,491 to Able ("Able") or U.S. Patent No. 759,946 to Weber ("Weber"). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." As noted above, the cited art fails to disclose a first surface disposed between a second surface and a first ply.

Neither Able nor Weber corrects the deficiency noted above by disclosing or suggesting a first surface disposed between a second surface and a first ply. Specifically, while Able discloses a card display including a base 12 and a plurality of sections 14, the sections are joined to the base 12 via welds 38, 44, 46, 48 (col. 6, lines 33-40, see also Fig. 1)

at a front surface of the base 12. If this front surface is determined to be the second surface (each of claims 1-27 recite the first and second plies being attached to the second surface), then the back of the base 12 must be the first surface. Thus, in a manner almost identical to Eckstein, the first surface is not and can not be disposed between the second surface and a first ply as is recited in each of claims 3, 6, 7, 12-18, 20 and 26.

Weber also fails to disclose a first surface disposed between a second surface and a first ply. Instead, Weber discloses an easel and does not disclose a first or second ply of any sort, let alone a first or second ply being attached to a second surface of a flexible substrate. Thus, Weber can not disclose or suggest a first surface disposed between a second surface and a first ply as is recited by each of claims 3, 6, 7, 12-18, 20 and 26. The applicants respectfully request withdrawal of the rejection of claims 3, 6, 7, 12-18, 20 and 26.

### Conclusion

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof is respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards, allowance, the examiner is urged to telephone the undersigned at the indicated number. Enclosed is a check in the amount of \$200.00 for one additional independent claim. If any additional fees or refunds are required, the Commissioner is directed to charge or credit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Respectfully submitted,

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